

The opinion in support of the decision being entered today is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT J. SKVORECZ

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Appeal 2006-1989  
Application 09/772,278<sup>1</sup>  
Patent 5,996,948  
Technology Center 3600

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Decided: March 28, 2007

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Before BRADLEY R. GARRIS, FRED E. MCKELVEY, and ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

AFFIRMED-IN-PART

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<sup>1</sup> Application filed March 15, 2001, seeking to reissue U.S. Patent 5,996,948, issued December 7, 1999, based on application 09/005,787, filed January 12, 1998 as a continuation-in-part of application 08/864,562, filed May 28, 1997. The real party in interest is Appellant (Brief at page 1).

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## STATEMENT OF CASE

Applicant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-5 and 7. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The only independent claim under appeal reads as follows:<sup>2</sup>

1. A wire chafing stand comprising a first [*an upper*] rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, [*a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area*] and having at least two [*a plurality of*] wire legs with each wire leg having two upright sections interconnected to one another [*at a location below the lower rim*] in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90° with respect to a horizontal plane through said base support and being affixed to the first [*upper*] rim adjacent one end thereof [*and to said lower rim at a relatively equal distance below the point of attachment to said upper rim*] and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said first [*upper*] rim for laterally displacing each wire leg relative to said first [*upper*] rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging.

The Examiner rejected claims 1-5 and 7 under 35 U.S.C. § 251 as being an improper recapture of surrendered subject matter (Final 2-6). The

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<sup>2</sup> Underlining indicates additions and [*brackets*] indicate deletions by amendment.

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Examiner also rejected claims 1, 2, and 5 under 35 U.S.C. § 102(b) (Final 6-7).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Buff US 5,503,062 Apr. 2, 1996  
(Filed Jan. 5, 1994)

The Examiner indicated that claim 6 is allowable (Final 7).

A copy of the claims 1-3, 5, and 7 under appeal is set forth in the Claim Appendix of Appellant's Brief. The copy of claim 4 in the appendix is in error. Contrary to the appendix, claim 4 as filed and appealed contains a spelling error ("defing" rather than "defining") which has yet to be corrected.

The Examiner concluded that (1) under the three step *Pannu* process Appellant's amendment and statement in the patented file resulted in surrender of subject matter relating to the lower rim (Final 3-5); and (2) Buff discloses the limitations of claims 1, 2, and 5 (Final 6-7). *See Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1371, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001).

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Appellant contends the Examiner has erred because (1) “there was never any surrender of subject matter relating to the lower rim aspect of the invention during the prosecution of the original application” (Br. 14); and (2) the Examiner has failed to demonstrate the prior art teaches or suggests each claim limitation (Br. 7).

We affirm the decision of the Examiner rejecting claims 1 and 2 under 35 U.S.C. § 102(b). We reverse the decision of the Examiner rejecting claim 5 under 35 U.S.C. § 102(b). We reverse the decision of the Examiner rejecting claims 1-5 and 7 under 35 U.S.C. § 251. We use our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection of claims 1-5 and 7.

## ISSUES

The issues before the Board are:

(1) Whether Appellant has established the Examiner erred in finally rejecting claims 1-5 and 7 under 35 U.S.C. § 251 because Appellant has rebutted the Examiner’s initial prima facie showing of recapture?

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(2) Whether Appellants have established the Examiner erred in rejecting claims 1, 2, and 5 under 35 U.S.C. § 102(b) because claimed limitations are not taught by Buff?

## FINDINGS OF FACT

The following findings of fact are believed to be supported by a preponderance of the evidence.

### A. *The Invention*

1. Appellant invented a wire chafing stand. The wire chafing stand permits multiple wire chafing stands to be nested and readily separated from one another without causing wedging. (Specification, col. 1, ll. 51-53).

2. Appellant states at column 3, lines 21-27, that:

FIG. 1-6 . . . illustrate a pair of nested wire chafing stands 10 of identical construction with each stand 10 including an upper rim 12 of any desired geometry, such as oval, square or rectangular, and a lower rim 14 of a geometry substantially identical to that of the upper rim 12.

3. Appellant states at column 3, lines 29-32, that:

The upper rim 12 is spaced apart from the lower rim 14 by wire legs 16 so that the upper and lower rims are in a substantially parallel relationship.

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4. Appellant states at column 3, lines 60-63, that:

Each wire leg 16 is preferably bent from a single straight wire rod into a somewhat "U" shaped configuration having two sides 19 and a base 20 with the sides 19 extending outwardly from the base 20 of the leg 16.

5. Appellant states at column 4, lines 7-10, that:

To readily facilitate nesting between wire stands 10 each side 19 of each wire leg 16 includes at least one offset 30 located near the upper end 18 of the wire leg 16 which displaces the side 19 of the wire leg 16 laterally.

6. Appellant states at column 4, lines 13-20, that:

The offset 30 indents the wire leg 16 so as to cause a lateral displacement of each side 19 of each wire leg 16 in a substantially horizontal direction from a predetermined location below the upper rim 12. This enables the wire legs 16 of a single wire chafing stand 10 to readily nest within another wire chafing stand 10 without interference and minimizes one wire stand 10 from wedging within another.

7. Appellant states at column 4, lines 47-50, that:

FIGS. 7, 8 and 9 show another embodiment of the present invention having only two wire legs 26 for supporting the chafing stand 10 from its opposite ends along its longitudinal axis.

8. Appellant states at column 4, lines 50-53, that:

Each wire leg 26 is formed from a single wire rod by a series of bending operations. Each wire leg 26 includes two somewhat

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"U" shaped sections 29 connected through an intermediate section 15 extending therebetween.

9. Appellant states at column 4, lines 53-55, that:

The intermediate section 15 forms a handle for holding the chafing stand 10 from its opposite ends.

10. Appellant states at column 4, lines 55-58, that:

Each of the "U" shaped sections 29 has a configuration substantially identical to that of one of the wire legs 16 in the first two embodiments of FIGS. 1-6 . . .

11. Appellant states at column 5, lines 9-19, that:

Another embodiment is shown in FIGS. 10-11 in which the wire legs 26 contain offsets 40 and 41 located at the point of interconnection of the wire leg 26 and the upper rim 12 of the stand 10. The offsets 40 and 41 support the upper rim 12 to enhance the weld 33 between the upper rim 12 and the wire legs 26 as shown in FIG. 11 forming a structurally sound frame for the stand 10. The offsets 40 and 41 also facilitate the nesting of multiple wire chafing stands. A variation of this embodiment is shown in FIGS. 12-13 in which offsets 42 are formed in the upper rim 14 of the chafing stand 10.

#### *B. Prosecution history of the original application*

12. As noted earlier, the patent sought to be reissued was based on application 09/005,787 ("original application"), filed January 12, 1998 as a continuation-in-part of application 08/864,562, filed May 28, 1997.

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13. As filed, the original application contained claims 1-7.

14. As filed, claim 1 was as follows:

A wire chafing stand comprising an upper rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area and having a pair of wire legs of equal length affixed at one end thereof to the upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire leg such that the upper rim and the lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the lower rim to uniformly support the stand at opposing ends thereof and having a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween.

15. On April 23, 1999, the Examiner entered a Non-final Office action.

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16. Claim 1-3 were rejected under 35 U.S.C. § 102 as being unpatentable over Andrews, US Patent 1,688,864, issued in October 1928. Claim 1 was rejected under 35 U.S.C. § 102 and claims 2-7 were rejected under 35 U.S.C. § 103 as being unpatentable over Fordyce, US Patent 4,718,402, issued in January 12, 1988.

17. Andrews and Fordyce are prior art vis-à-vis applicant under 35 U.S.C. § 102(b).

18. On July 26, 1999, Appellant filed an Amendment (“the amendment”) responding to the Examiner’s first Office action.

19. The amendment amended claims 1, 2, 5, and 6, and cancelled claim 7. After entry of the amendment, the application claims were 1-6.

20. Claim 1 was amended as follows (underlining indicates additions and [brackets] indicate deletions):

A wire chafing stand comprising an upper rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area and having a plurality of wire legs with each wire leg having two upright sections interconnected to one another at a location below the lower rim in a configuration

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forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90° with respect to a horizontal plane through said base support and being affixed to the upper rim adjacent one end thereof and to said lower rim at a relatively equal distance below the point of attachment to said upper rim and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said upper rim for laterally displacing each wire leg relative to said upper rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging [ pair of wire legs of equal length affixed at one end thereof to the upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire such that the upper rim and the lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the lower rim to uniformly support the stand at opposing ends thereof and having a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween].

21. In the amendment at page 4, Appellant stated three points as follows:

Additionally, claim 1 requires each wire leg to have two upright sections which are interconnected at a location below the lower rim in a configuration forming a base support for the stand to rest upon.

Furthermore, each upright section of the wire chafing stand as now defined in cla[i]m 1 extends upwardly from the base support at an angle equal to or greater than 90° with respect to a horizontal plane through the base.

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[Wedging] is overcome by the use of a plurality of offsets located either in the upright sections of the wire legs or in the upper rim. The offset construction laterally displace[s] each wire leg relative to the upper rim . . .

22. On August 12, 1999, the Examiner entered a Notice of Allowability and Examiner's Amendment indicating claims 1-6 were allowable.

23. Consistent with Office practice, the claims were re-numbered in the course of preparing the original application for issue, all as follows:

Chronological by original claim

<u>Original claim number</u>	<u>Claim as re-numbered</u>
1	1
2	2
3	3
4	4
5	6
6	5
7	Cancelled

24. On October 14, 1999, Appellant filed an Amendment under 37 C.F.R. § 1.312 to correct Figures 12 and 13. As filed, the offsets in the upper rim of Figures 12 and 13 do not laterally displace each wire leg relative to said upper rim as required by amended claim 1. The amendment

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sought to reverse the direction of the offset from toward the center of the upper rim to away from the center.

25. U.S. Patent 5,996,948 issued December 7, 1997, based on the original application and contained claims 1-6 with originally filed Figures 12 and 13.

26. On January 20, 2000, the Examiner notified Appellant that entry of the Amendment under 37 C.F.R. § 1.312 was disapproved as the new “away from the center” direction of the offset was not supported by the original disclosure.

### *C. Prosecution of reissue application*

27. Applicant filed reissue application 09/772,278 on March 15, 2001, seeking to reissue U.S. Patent 5,996,948.

28. Applicant presented amended versions of original patent claims 1 and 3 along with new reissue application claim 7 for consideration.

29. A copy of reissue application claims 1-7 appears in the Claim Appendix of Appellant’s Brief.

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30. The Examiner has rejected reissue application claims 1-5 and 7 under 35 U.S.C. § 251 maintaining that the claims seek to "recapture" subject matter surrendered in obtaining allowance of the claims which appear in the patent sought to be reissued (Final 2-6).

31. The Examiner also rejected claims 1, 2, and 5 under 35 U.S.C. § 102(b) (Final 6-7). The prior art relied upon by the Examiner in rejecting the claims on appeal is Buff, US 5,503,062, issued April 2, 1996.

32. Reissue application claims 1-5 and 7 are before the Board in the appeal.

33. The Examiner based the rejection of claims 1-5 and 7 on the grounds that when faced in the original application with a rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103 over Andrews, Appellant made two significant amendments:

(1) *First*, Appellant amended originally filed claim 1 to add a limitation reading "each wire leg having two upright sections interconnected to one another at a location below the lower rim in a configuration forming a base support for the stand to rest upon."

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(2) *Second*, Appellant amended originally filed claim 1 to add a limitation reading “affixed to the upper rim adjacent one end thereof and to said lower rim at a relatively equal distance below the point of attachment to said upper rim.”

D. *Examiner's Rejections*

(1)  
35 U.S.C. § 251

34. The Examiner rejected reissue application claims 1-5 and 7 as being unpatentable under 35 U.S.C. § 251 for recapturing subject matter surrendered in obtaining allowance of claims during prosecution of the application which matured into the patent sought to be reissued.

35. The Examiner applied the three step *Pannu* test to determine recapture.

36. The Examiner reasoned as set forth in pages 2-6 of the Final Office Action entered December 30, 2004. Particularly, the Examiner reasoned that the following broadened (by deletion) aspects of reissue claim 1, related to surrendered subject matter:

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- (1) “a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area;”
- (2) “at a location below the lower rim;” and
- (3) “and to said lower rim at a relatively equal distance below the point of attachment to said upper rim.”

37. The record supports the Examiner's findings with respect to what limitations do not appear in reissue application claim 1 which were present in claim 1 of the original application, as allowed.

(2)  
*35 U.S.C. § 102(b)*

38. The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. § 102(b) as being anticipated by Buff (Final 6-7).

39. The Examiner reasoned as follows (see the Final Office Action entered December 30, 2004, pages 6-7):

Regarding claim 1, Buff, IV discloses a wire support (Fig.2) comprising a first rim (40) of wire steel which forms a closed geometrical configuration circumscribing a first surface area, and having at least two wire legs (49, Fig. 2) with each

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wire leg having two upright sections interconnected to one another in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from the base support to form an angle greater than 90 degrees with respect to a horizontal plane through the base support and being affixed to the first rim adjacent one end thereof, and further comprising a plurality of offsets (52) located either in the upright sections of the wire legs or in the first rim for laterally displacing each wire leg relative to the first rim. The offsets can facilitate the nesting of a multiplicity of stands into one another without significant wedging (see Col. 5, lines 13-16 and lines 30-34).

Regarding claim 2, Fig. 2 of Buff, IV also shows the plurality of offsets (52) being in the upright section and divided each upright section into two sections lying in different planes relative to one another.

Regarding claim 5, Fig. 2 of Buff, IV also appears to show the plurality of offsets being welded or coupled to the wire legs at the separation (separation between the legs and the handle 38) of the upright section into segments. Nevertheless, referring to the process step such as welding is not accorded patentable weight in the product-by-process claim. It is well settled that the patentability of a product does not depend on its method of production. Product -by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 USPQ 15.

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## DISCUSSION – REJECTION UNDER 35 U.S.C. § 251

### A. *The Prima Facie Case*

Our Findings of Fact 33-36 set out the basis upon which the Examiner made a recapture rejection. As noted in Finding 37, the record supports the Examiner’s findings.

Contrary to Appellant’s position at page 6 of the Reply Brief, we conclude that the Examiner’s rejection sets forth a prima facie case of reissue recapture. That is, the Examiner has established a rebuttable presumption of recapture. Appellant may rebut the Examiner’s prima facie case by showing, based on the record, that at the time the amendment was made, an “objective observer” could not reasonably have viewed the subject matter broader than any narrowing amendment as having been surrendered.

*See Ex parte Willibald Kraus*, Appeal 2005-0841, 2006 WL 3939191, (Bd.Pat.App & Int., Sep. 21, 2006) for a discussion of reissue recapture.

### B. *Appellant’s Response To The Examiner’s Case*

Appellant argues (Br. 14) that during prosecution of the original application the defined relationship of the lower rim was not narrowed.

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Rather, it was broadened or unaffected by the amended language. We agree.

While at first blush we find support for the Examiner's *prima facie* showing of recapture, a closer review finds Appellant's position to be correct. First, as to the limitation "a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area," this limitation was part of claim 1 as originally filed and was not added by amendment. Therefore, there can be no surrender with respect to this limitation.

Second, as to the added limitation "at a location below the lower rim," this limitation is redundant to the limitation that follows it in the claim ("in a configuration forming a base support for the stand to rest upon") which inherently requires interconnection of the uprights be below every other element of the chafing stand. Therefore, removal of this limitation does not in fact broaden the claim.

Third, as to the added limitation "and to said lower rim at a relatively equal distance below the point of attachment to said upper rim," this

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limitation is merely a restatement of an original claim limitation (“the upper rim and the lower rim lie in substantial parallel alignment to one another”) and is not in fact a limitation added by amendment.

We find the record of the original application would lead an objective observer to conclude with respect to limitations related to the lower rim that no deliberate surrender happened in order to avoid an obstacle to patentability. *Yoon Ja Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006).

We conclude that while the Examiner has initially demonstrated a prima facie case of reissue recapture, the Appellant has rebutted that prima facie case by showing the broader “lower rim” aspects of the reissued claim do not relate to surrendered subject matter.

## DISCUSSION – REJECTION UNDER 35 U.S.C. § 102

### A. *The Prima Facie Case*

Finding of Fact 39 sets forth the Examiner’s prima facie case for anticipation with respect to claims 1, 2, and 5.

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B. *Claim 1 - Appellant's response to the Examiner's case*

First, Appellant argues at pages 7-8 of the Brief that the Examiner has erred because the claimed “offset” is a lateral displacement and Buff only teaches a longitudinal displacement. That is, claim 1 is patentable because Buff fails to teach offsets from the lateral sides (short axis). We disagree.

Findings of Fact 4-6 and Appellant’s Figures 1-3 contradict Appellant’s argument. Appellant describes each leg 16 as “U” shaped with two sides 19. Each side 19 is described as including an offset 30 which causes a lateral displacement. Figures 1-3 clearly show a first side 19 of each leg is attached to a long axis side of a rim and a second side 19 of each leg is attached to a short axis side of the rim. Thus, Appellant’s disclosed lateral displacement includes in a longitudinal direction. Appellant’s Specification never limits the term “lateral” to describing the short axis side. Rather, Appellant’s Specification only uses “lateral” in the broader sense of sideways from either the long axis or short axis.

Second, at pages 8-9 of the Brief, Appellant argues the Examiner has erred because:

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Since the offsets 52 in Buff ‘062 are disposed or formed over the support wire 40, they cannot be “located either in the upright sections (19) of the wire legs (16) or in said first rim (12)” but can only be located at the coupling between the handles 38 and support members 50 as Buff ‘062 teaches. Thus the members 52 cannot be located in the specified alternative locations called for in reissue claim 1.

We disagree.

As shown by Findings of Fact 8 and 9, Appellant describes his handle 15 as part of leg 26. Thus, it is reasonable to view the offset between Buff’s handle 38 and support member 50 as being located in an upright section of a wire leg since both 38 and 50 can form part of the leg.

Third, at pages 9-10 of the Brief, Appellant argues the Examiner has erred because while Buff has offsets the Examiner fails to show that Buff has offsets “to facilitate the nesting of a multiplicity of stands into one another without significant wedging” as recited in claim 1. We disagree.

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows sound basis for

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believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. *See also Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

The Examiner correctly found that Buff established a prima facie case of anticipation. At that point, the burden shifted to Appellant to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). Appellant has failed to demonstrate that the functional characteristics of his claimed invention are not inherent in the structure disclosed by Buff.

Fourth, Appellant argues at page 10 of the Brief that the Examiner has erred because Buff fails to disclose the claimed “at least two wire legs (16)

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with each wire leg (16) having two upright sections (19) interconnected to one another in a configuration forming a base support (20) for the stand to rest upon” (numbers added by Appellant). We disagree.

Appellant’s Specification describes two major embodiments. The first embodiment (see Fig. 1) has four legs 16 with each leg having two upright sections 19. Two of the four legs are found at each end of the long axis. The second embodiment (see Fig. 7) has two legs 26 with each leg having four upright sections 19. One of the two legs is found at each end of the long axis. Appellant’s claim 1 is broader than either embodiment as it requires only “at least two legs” each having “two uprights.” We turn to Buff’s Figure 2 where we find two legs (formed by item 49, two upright ends 50 (see Buff’s Fig. 1), two offsets 52, and at least the lower section of handles 38) with each leg having two upright sections (aforementioned 50, 52, and 38). This arrangement is on its face a configuration forming a base support for the stand to rest upon. Although the legs in Buff run along the long axis of the base rather than across the end of the long axis as disclosed by Appellant, such is not precluded by Appellant’s claim language.

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Therefore, we conclude Appellant has *not* shown that the Examiner erred with respect to this rejection under 35 U.S.C. § 102.

C. *Claim 2 – Appellant’s response to the Examiner’s case*

At page 11 of the Brief, Appellant again argues that the Examiner has erred because Buff fails to disclose each wire leg having two upright sections. Again we disagree for the reasons *supra*. No additional arguments are presented.

Therefore, we conclude Appellant has *not* shown that the Examiner erred with respect to this rejection under 35 U.S.C. § 102.

D. *Claim 5 – Appellant’s response to the Examiner’s case*

At page 11 of the Brief, Appellant again argues that the Examiner has erred because in Buff “the separation of the upright sections into segments has no correlation to the device taught in Buff ‘062.” We agree.

Claim 5 is limited by its terms (“said plurality of offsets are welded to said wire legs”) to only one of the two offset embodiments of claim 1. Specifically, the embodiment with “a plurality of offsets located . . . in said upper rim.” Although Buff does teach an offset in the rim, Buff’s offset in

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the rim has not been shown to be “for laterally displacing each wire leg relative to said upper rim” as required by claim 1.

Therefore, we conclude Appellant has shown that the Examiner erred with respect to this rejection under 35 U.S.C. § 102.

## DISCUSSION – NEW GROUNDS OF REJECTION

### A. *Rejection under 35 U.S.C. § 112, Second Paragraph*

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites “at the separation of the upright sections into segments.” The meaning of this recitation is indefinite because there is no antecedent basis for “the separation” and because it is unclear what is being described by the term “segments.”

### B. *Rejection under 35 U.S.C. § 112, First Paragraph*

Claims 1-5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims

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contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 1 recites “a plurality of offsets located . . . in said first rim for laterally displacing each wire leg relative to said first rim.” This limitation has no support in Appellant’s Specification as filed. While the Appellant’s originally filed Figures 12 and 13 describe offsets in the rim, those offsets do not laterally displace the wire leg relative to the rim. Rather, offsets in the rim which do laterally displace the wire leg relative to the rim are *only described* in amended Figures 12 and 13 found in the Amendment to the drawings filed October 14, 1999. The original Examiner found those amended figures to be new matter and entry of the Amendment was denied (Appellant notified January 20, 2000).

Claim 5 recites a further limitation of the offsets in the rims.

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## DECISION

The decision of the Examiner rejecting claims 1-5 and 7 under 35 U.S.C. § 251 based on recapture is *reversed*; the decision of the Examiner rejecting claim 5 under 35 U.S.C. 102(b) is *reversed*; and the decision of the Examiner rejecting claims 1 and 2 under 35 U.S.C. § 102(b) is *affirmed*.

We have entered new grounds of rejection against claims 1-5 and 7 under 37 C.F.R. § 41.50(b) (2005).

37 C.F.R. § 41.50(b) provides that, “new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) (2005)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

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(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART  
37 C.F.R. § 41.50(b)

tdl

ANDERSON, KILL & OLICK, P.C.  
1251 AVENUE OF THE AMERICAS  
NEW YORK, NY 10020-1182